

## **REMARKS**

### **Status of the Claims**

Claims 1-59 were pending and stand rejected. Applicants acknowledge with thanks the withdrawal of the prior restriction requirement. Action at page 2. Applicants currently amend herein claims 1, 2, 14, 25, 35, 41, 43, 44, 50, and 56; cancel claims 18-21, 42, 45-49, and 59 without prejudice or disclaimer; and add new claims 60-70. Accordingly, now pending are claims 1-17, 22-41, 43, 44, 50-58, and 60-70.

The amendments and new claims add no new matter. Specifically, independent claims 1, 2, 35, 43, and 44 are amended to include “a solubilizing agent selected from the group consisting of a block polymer surfactant, a polyvinyl alcohol-containing polymer surfactant, and a mixture thereof, wherein the solubilizing agent is present in an amount sufficient to prevent separation of the volatile agent from the composition.” Support for this amendment is found in the specification, e.g., at paragraphs [0053] to [0071] and paragraph [0080]. The claims are also amended to delete a dispersion aspect. Claims 14 and 25 are amended merely to correct typographical errors. Claim 41 is amended to recite “a pigment in an amount sufficient to impart to the eyelash a color other than white when the composition is foamed.” Support can be found throughout the specification, e.g. at paragraphs [0046] and [0079]. Claim 50 is amended to reflect the amendments of claim 2, from which it depends; and claim 56 is amended to depend from claim 52, support for which can be found, e.g., at paragraph [0072]. Accordingly, none of the amendments add new matter.

The new claims also present no issues of new matter. New claims 60-64 recite “a block polymer surfactant” support for which is found, e.g., in paragraph [0054] to [0069]. New claims 65-69 concern specific and alternative volatile agents. Support for “isopentane” can be found, e.g., in Example 16, paragraph [0092] and original claim 33, which teaches the use of isopentane as the volatile agent. Support for the Markush groups can be found, e.g., in paragraph [0043] and in original claim 33. New claim 70 relates to a “non-pressurized container”, which finds support throughout the specification, e.g., see Abstract, last line. Accordingly, the new claims are also free of new matter.

With respect to all amendments and cancellations, Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections

made by the Patent Office. Applicants reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional applications.

### **Claim Rejections**

#### **35 U.S.C. § 112, ¶1 (Written Description)**

The Office rejected claims 1-59 under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. Action at pages 2-7. The Office's contentions appear to be directed against various functional limitations of the claims (e.g., "produce an expanded composition," "fix at least a portion of the expanded composition," "swell the composition," "imparting a volumizing effect," "increases radial configuration of the composition," etc.). Applicants submit that the Office's position is inconsistent with the law and respectfully request reconsideration and withdrawal of the rejections.

"There is a **strong presumption** that an adequate written description of the claimed invention is present when the application is filed" and "[c]onsequently, **rejection of an original claim for lack of written description should be rare.**" MPEP § 2163; In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) ("we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims"). The claims rejected by the Office are those **originally filed** in this application and the Office clearly has not met this burden. One needs to look no further than the claims as filed for written description, although the remainder of the specification is also replete with additional, essentially *verbatim*, support. For example, the application discloses that "[w]hen the post-expanding composition of the present invention is applied on hair fibers, such as the eyelashes, the volatile agent will release and cause the surfactant and solvent for the surfactant to swell/expand the composition. When the film forming agent sets, it fixes at least a portion of the swelled/expanded composition on the eyelashes in its swelled/expanded state, thereby imparting a volumizing effect to the eyelashes." See paragraph [0038]. It cannot reasonably be said that one skilled in the art would question whether the inventors were in possession of the invention recited in this passage and claimed in the originally-filed claims.

This is not, for example, a case where a composition is claimed solely by functional limitations without a known structure-function correlation, see Regents of the University of California v. Eli Lilly, 119 F.3d 1559 (Fed. Cir. 1997), or where treatment based on a biological mechanism or action is claimed without identifying a single suitable drug, see Univ. of Rochester v. G.D. Searle & Co., 358 F.3d 916 (Fed. Cir. 2004), nor does the Office contend that a critical element is omitted from the claims, see Gentry Gallery v. Berkline Corp., 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998).

Rather, the Office's sole contention appears to be that there are not actual working examples providing recorded experimental proof of each functional limitation for every composition encompassed by the independent claims, e.g., asserting that the "specification teaches compositions but does not teach any of the compositions actually possessing the required property in claims 1-2, 35 and 43-44 and thus what is disclosed is not representative of the genus ... ." Action at page 7. Applicants respectfully point out that every claimed embodiment need not be exemplified for at least the reason that **"examples are not necessary to support the adequacy of a written description."** See Falkner v. Inglis, 448 F.3d 1357, 1366 (Fed. Cir. 2006). Indeed, it is not even necessary that an invention be reduced to practice to satisfy the written description requirement. Id. In particular, the MPEP makes clear that **"[t]he written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice ... or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties ... sufficient to show the applicant was in possession of the claimed genus."** See MPEP § 2163 3.(a).ii (citing Regents of the University of California v. Eli Lilly & Co., 119 F.3d 1559, 1568 (Fed. Cir. 1997) (emphasis added).) At the minimum, the functional language cited by the Office supports, rather than negates, written description because it demonstrates that the inventors broadly considered these function attributes to be part of the invention and did not intend to be limited to specific compositions.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the written description rejections directed at claims 1-59.

### **35 U.S.C. § 112, ¶2 (Indefiniteness)**

The Office rejected claims 18 and 19 under 35 U.S.C. § 112, second paragraph, for

alleged indefiniteness. Action at page 7. In particular, the Office found claims 18 and 19 unclear in that one refers to a composition that is “water-rinseable”, while the other refers to a composition “resistant to water rinsing.” *Id.*

Applicants respectfully disagree with the rejection and submit that one skilled in the art would have no difficulty ascertaining the metes and bounds of the water-rinseable composition, on the one hand, and the water-resistant composition, on the other, as originally claimed. However, solely to expedite allowance, and without waiver or disclaimer of Applicant’s right to pursue the identical subject matter in one or more continuing applications, claims 18 and 19 are canceled herein, thus rendering moot the indefiniteness rejections of these claims.

The Office rejected claim 22 under 35 U.S.C. § 112, second paragraph, also for allegedly being indefinite. Action at page 7. Specifically, the Office contended that claim 22 lacks clarity due to the recitation of trademarks. *Id.*

Applicants respectfully point out, however, that the terms “MEROXAPOL,” “POLOXAMER,” and “POLOXAMINE” are not trademarks, but rather the names used to describe specific block polymer surfactants under the International Nomenclature of Cosmetic Ingredients, abbreviated INCI. As INCI names, there is no indefiniteness with respect to their use as recited in the claim.

The Office rejected claim 41 under 35 U.S.C. § 112, second paragraph, also for alleged indefiniteness. Action at page 7. Specifically, the Office found claim 41 indefinite for failing to specify the amount of colorant “sufficient to mask the color.” *Id.*

Applicants respectfully traverse this rejection and submit that one skilled in the art would understand, based on a reading of the instant application, that many foams are white in appearance due to the interaction of light with the cellular structure of the foam. For example, many shaving gels use dyes to impart a colored appearance to the gel. However, when the same gel begins to foam, the initial color is lost and the foam takes on a white appearance. Typically, a mascara is highly pigmented and intended to provide a strong coloring effect to the lashes and the use of a foam may therefore appear incompatible with a mascara. However, the invention solves this problem by selecting levels of pigments such that the composition appears colored even after the foam has expanded. See, e.g., paragraphs [0044] to [0048] and [0079]. For additional clarity, claim 41 is amended herein to call for “a pigment in an amount sufficient to

impart to the eyelash a color other than white when the composition is foamed.” As noted above, this amendment finds support throughout the specification as filed, an in particular at paragraph [0046] where it is disclosed that the “composition of the present invention, optionally, incorporates one or more colorants in an amount sufficient to mask the color of the foam, which is usually white, so that when the composition of the present invention is applied to the hair, it imparts a color thereto other than white.” Applicants thus respectfully submit that one skilled in the art would have no difficulty understanding what amount of pigment is required to mask the white appearance of a given foam composition.

Finally, the Office rejected claim 42 under 35 U.S.C. § 112, second paragraph, for alleged indefiniteness due to a lack of antecedent basis. Action at page 7. Nonetheless, the rejection is rendered moot in view of the cancellation of claim 42, made without prejudice, disclaimer nor acquiescence to the Office’s contentions.

For at least the above reasons, Applicants respectfully request reconsideration and withdrawal of the indefiniteness rejections directed at claims 22 and 41.

### **Double Patenting**

The Office provisionally rejected claims 1-59 on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-50 of co-pending Application Serial No. 10/502,061; and over claims 3-5, 7, 9-13, 18-24, 27, 28, and 31-38 of co-pending Application Serial No. 10/331,069. Inasmuch as these are provisional rejections, Applicants respectfully request that they be held in abeyance pending the determination of patentable subject matter.

The Office also provisionally rejected claims 1-33 and 35-59 on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-55 of co-pending Application Serial No. 10/532,362. Please note that the ‘362 application has been abandoned by not responding to the July 17, 2009 Office Action. Accordingly, the provisional double patenting rejection relating to the ‘362 application is moot.

**CONCLUSION**

Applicants respectfully submit that the currently-pending claims are in condition for allowance.

If a telephone call would facilitate any aspect of the prosecution of the instant application, Applicants encourage the Examiner to contact the undersigned at the number provided.

Respectfully submitted,

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